

REMARKS

At the time of the Office Action dated April 7, 2003, claims 1-4 were pending, all of which have been rejected under §103(a). In this Amendment, claim 1 has been amended, claim 4 has been cancelled, and new claims 7-10 has been added. Specifically, Applicants have amended claim 1 to include the limitation recited in claim 4 and to improve wording. Adequate descriptive support for new claims 7-10 can be found in, for example, the third full paragraph at page 4, the first full paragraph at page 7, and the last paragraph at page 8 bridging pages 8 and 9. No new matter is introduced.

Claim 4 has been objected to because of informality and rejected under 35 U.S.C. §103(a). By this Amendment, claim 4 has been canceled, thus obviating the objection and rejection. Accordingly, withdrawal of the objection and rejection with respect to claim 4 is respectfully requested.

Claims 1, 3 and 4 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang et al.

In the statement of the rejection, the Examiner asserted that the combination of the embodiments in Jiang et al. discloses all the limitations recited in the claims.

In response, Applicants have amended claim 1 as attached. In this amendment, Applicants have introduced to claim 1 the limitation "said adhesive layer extending outward relative to and **completely all the way around** the primary surface of said semiconductor element" recited in claim 4.

Applicants understand that Jiang et al. discloses, "It is, of course, understood that **the adhesive tape 108 may also extend past the semiconductor die edge 128**, as shown

in FIG. 10, with **visual inspection** being conducted viewing the semiconductor substrate back surface 114" (column 9, lines 9-12). However, the adhesive tape 108 **extends in width direction only** as the Examiner admitted in the statement of the rejection. Based on this, Applicants understand that Jiang et al. does **not** disclose the adhesive tape 108 extending outward relative to and **completely all the way around the semiconductor die edge 128**. Applicants further understand that the extended portion of the adhesive tape 108 is intended for visual inspection rather than for relieving stress/tension.

Accordingly, Applicants submit that Jiang et al. does not disclose, among other thing, the limitation "said adhesive layer extends outside an outer edge of the primary surface of said semiconductor element without reaching an outer edge of the primary surface of said circuit board, said adhesive layer **extending outward** relative to and **completely all the way around** the primary surface of said semiconductor element." Applicants, therefore, solicit withdrawal of the rejection of claims 1, 3 and 4.

Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang et al. in view of Taguchi et al.

In the statement of the rejection, the Examiner asserted that Jiang et al. teaches substantially the entire claimed structure as applied to claim 1. However, as the reason set forth above, amended claim 1 would not have been obvious over Jiang et al. because Jiang et al. does not disclose all the limitations recited in claim 1.

Moreover, the proposed combination of Jiang et al. in view of Taguchi et al., even if it were proper, does not disclose the above mentioned limitation "said adhesive layer

extending outward relative to and **completely all the way around** the primary surface of said semiconductor element."

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). It is therefore submitted that dependent claim 2 which depends from claim 1 is also patentable. Applicant, therefore, solicits withdrawal of the rejection of claim 2.

New Claims 7-10.

Applicants submit that new claims 7-10 are in condition for immediate allowance. Specifically, claims 7 recites that a method of reducing tension between a semiconductor element and a circuit board provided in a semiconductor device by using a specific adhesive layer. The adhesive layer "extends outside an edge of said semiconductor element without reaching an edge of said circuit board, said adhesive layer extending outward relative to and completely all the way around the primary surface of said semiconductor element." Jiang et al. and Taguchi et al., either individually or in combination, does not disclose such an adhesive layer itself, and also does not disclose reducing tension between a semiconductor element and a circuit board by using the adhesive layer.

Conclusion.

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding

issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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